

ESTTA Tracking number: **ESTTA516638**

Filing date: **01/17/2013**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Alice In Chains Partnership
Granted to Date of previous extension	01/20/2013
Address	c/o David Weise and Associates 16000 Ventura Blvd., Suite 600 Encino, CA 91436 UNITED STATES
Attorney information	ROBERT A BECKER FROSS ZELNICK LEHRMAN & ZISSU PC 866 UNITED NATIONS PLAZA NEW YORK, NY 10017 UNITED STATES rbecker@frosszelnick.com Phone:212-813-5900

Applicant Information

Application No	85491584	Publication date	07/24/2012
Opposition Filing Date	01/17/2013	Opposition Period Ends	01/20/2013
Applicant	Nancylayneco LLC c/o Law Offices of Peter F. Cowles, P.S. 5341 Ballard Avenue NW Seattle, WA 98107 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 1987/00/00 First Use In Commerce: 1987/00/00 All goods and services in the class are opposed, namely: Audio recordings featuring music and musical performances; Compact discs featuring music; Digital music downloadable from the Internet; Downloadable musical sound recordings; Downloadable music and multimedia files featuring musical performances via the internet and wireless devices
Class 041. First Use: 1987/00/00 First Use In Commerce: 1987/00/00 All goods and services in the class are opposed, namely: Entertainment services in the nature of live musical performances

Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)
<i>Torres v. Cantine Torresella S.r.l.Fraud</i>	808 F.2d 46, 1 USPQ2d 1483 (Fed. Cir. 1986)
Other	Applicant is not the owner of the mark and has not used it, so registration of the mark would violate 15 U.S.C. Sections 1051, 1052, and

	1127.
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Mark Cited by Opposer as Basis for Opposition

U.S. Application/ Registration No.	NONE	Application Date	NONE
Registration Date	NONE		
Word Mark	ALICE IN CHAINS		
Goods/Services	live musical performances and musical recordings		

Attachments	F1154894.PDF (11 pages)(477028 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Robert Becker/
Name	ROBERT A BECKER
Date	01/17/2013

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

In the Matter of the Application Serial No. 85/491,584
Published in the *Official Gazette* of July 24, 2012
Mark: ALICE IN CHAINS

ALICE IN CHAINS PARTNERSHIP,

Opposer,

v.

NANCYLAYNECO LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

Opposer, Alice in Chains Partnership (the “Partnership” or “Opposer”), a Washington partnership, which has an address c/o David Weise and Associates, 16000 Ventura Blvd., Suite 600, Encino, CA 91436, believes that it will be damaged by registration of the mark ALICE IN CHAINS shown in Application Serial No. 85/491,584, filed on December 9, 2011, for goods in International Class 9 and services in International Class 41, and therefore opposes the same. As grounds for this opposition, Opposer, through its attorneys, alleges as follows:

A. Opposer and its use of the ALICE IN CHAINS mark

1. Opposer is the owner of the trademark ALICE IN CHAINS (the “Mark”), which Opposer has used for live musical performances since 1987 and musical recordings since 1990.

2. In 1987 Jerry Cantrell (“Cantrell”), Sean Kinney (“Kinney”), Layne Staley (“Staley”), and Mike Starr (“Starr”) formed the musical group Alice in Chains, which began

providing live musical performances that year under the Mark, and began selling musical recordings under the Mark in 1990. Cantrell, Kinney, Staley, and Starr entered into an oral partnership that owned the Mark and controlled the quality of the goods and services marketed under the Mark. That partnership is the Alice in Chains Partnership, the Opposer herein.

3. In an agreement signed by Cantrell, Kinney, Staley, and Starr in or about July 1995 (the “1995 Agreement”), the parties confirmed that: 1) they had entered into the Partnership; and 2) all rights in the Mark were owned by the Partnership. As set forth in the 1995 Agreement, Starr withdrew from the Partnership and the musical group Alice in Chains. In addition, under the 1995 Agreement, Starr transferred his interest in the Partnership and the Mark to the remaining partners, namely, Cantrell, Kinney, and Staley. As of the execution of the 1995 Agreement, Starr ceased playing any role in contributing to or controlling the quality or nature of the goods and services marketed under the Mark. Starr died on or about March 8, 2011. After the execution of the 1995 Agreement, the Partnership, then made up of Cantrell, Kinney, and Staley, continued to use the Mark and control the quality of the goods and services offered under the Mark. The Partnership has continued to control the quality of the goods and services marketed under the Mark and to own the Mark through the present.

4. Staley died on or about April 5, 2002.

5. After Staley’s death, Cantrell and Kinney continued to manage the Partnership, through the present.

6. Nancy McCallum (“McCallum”) is Staley’s mother.

B. Applicant and its Opposed Application

7. On information and belief, Applicant, Nancylayneco LLC, is a Washington limited liability company with an address c/o Law Offices of Peter F. Cowles, P.S., 5341 Ballard Avenue NW, Seattle, WA 98107.

8. On information and belief, Applicant's sole member is McCallum.

9. On information and belief, Applicant is owned by McCallum.

10. On information and belief, Applicant is controlled by McCallum.

11. On information and belief, Applicant came into existence on January 21, 2010.

12. Applicant does not own the Mark.

13. Applicant has never owned the Mark.

14. Applicant has never sold or offered goods or services under the Mark.

15. The public and consumers do not associate the Mark with Applicant and Applicant owns no goodwill associated with the Mark.

16. Applicant does not control the quality of the goods and services marketed under the Mark.

17. Applicant has never controlled the quality of the goods and services marketed under the Mark.

18. On December 9, 2011, Applicant filed application Ser. No. 85/491,584 (the "Application") to register ALICE IN CHAINS for "Audio recordings featuring music and

musical performances; Compact discs featuring music; Digital music downloadable from the Internet; Downloadable musical sound recordings; Downloadable music and multimedia files featuring musical performances via the internet and wireless devices” in Class 9 and “Entertainment services in the nature of live musical performances” in Class 41, based on a claim of first use in United States commerce in 1987.

19. As part of the Application, McCallum signed a declaration stating that “she believes the applicant to be the owner of the trademark/service mark sought to be registered...; to the best of...her knowledge and belief no other person, firm, corporation, or association has the right to use the mark in commerce...” (This statement is hereafter referred to as the “Declaration Statement.”)

20. Applicant has never sold or offered audio recordings featuring music and musical performances, compact discs featuring music, digital music downloadable from the Internet, downloadable musical sound recordings, or downloadable music and multimedia files featuring musical performances via the Internet and wireless devices under the Mark.

21. Applicant has never sold or offered entertainment services in the nature of live musical performances under the Mark.

22. Applicant does not purport to claim any right in the Mark other than any right that it or McCallum may have obtained as successor-in-interest to Staley.

23. On June 14, 2012, Opposer’s attorneys e-mailed Applicant’s attorneys a copy of the 1995 Agreement.

COUNT ONE
APPLICANT IS NOT THE OWNER OF THE APPLIED-FOR MARK

24. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 23 above as if fully set forth herein.

25. Applicant is not, and was not at the time of filing the Application, the rightful owner of the Mark it is applying for, and thus registration of the applied-for Mark by Applicant would violate Section 1(a) of the Lanham Act, 15 U.S.C. § 1051.

26. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of that Mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the ALICE IN CHAINS mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

COUNT TWO
LACK OF USE OF THE MARK

27. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 26 above as if fully set forth herein.

28. Applicant has never used the Mark in commerce, as defined by 15 U.S.C. § 1127, to indicate source in Applicant to consumers.

29. Upon information and belief, Applicant has not used the Mark in United States commerce.

30. As a result of the lack of use of the Mark in commerce, notwithstanding Applicant's claim of use, the Application is void *ab initio*. Any registration issued based on the Application would be in violation of §§ 1, 2, and 45 of the Lanham Act, 15 U.S.C. §§ 1051, 1052, and 1127.

31. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of that Mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the ALICE IN CHAINS mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

COUNT THREE
FRAUD ON THE PTO IN FILING APPLICATION

32. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 31 above as if fully set forth herein.

33. When Applicant filed the Application, Applicant did not believe that Applicant was the owner of the Mark.

34. When Applicant filed the Application, Applicant did not believe that no other person, firm, corporation, or association had the right to use the Mark in commerce.

35. On information and belief, when Applicant filed the Application, Applicant knew that the Declaration Statement was false.

36. Therefore, Applicant knowingly made a false, material misrepresentation of fact when it filed the Application, with the intent to defraud the United States Patent and Trademark Office by claiming to be the owner of a Mark of which it was not the owner and claiming that no

other person, firm, corporation, or association had the right to use that Mark in commerce when in fact Opposer had such right, and by obtaining a registration based on such fraudulent claims.

37. Thus, Applicant committed fraud on the United States Patent and Trademark Office.

38. Registration of the Mark must be refused. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of that Mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the ALICE IN CHAINS mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

COUNT FOUR **FRAUD ON THE PTO IN MAINTAINING APPLICATION**

39. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 38 above as if fully set forth herein.

40. Since June 14, 2012, when Opposer's attorneys e-mailed Applicant's attorneys a copy of the 1995 Agreement, Applicant has not believed that Applicant is the owner of the Mark.

41. Since June 14, 2012, when Opposer's attorneys e-mailed Applicant's attorneys a copy of the 1995 Agreement, Applicant has not believed that no other person, firm, corporation, or association has the right to use the Mark in commerce.

42. Since June 14, 2012, when Opposer's attorneys e-mailed Applicant's attorneys a copy of the 1995 Agreement, Applicant has known that the Declaration Statement was false.

43. Therefore, since June 14, 2012, when Opposer's attorneys e-mailed Applicant's attorneys a copy of the 1995 Agreement, Applicant has known that it made a false, material misrepresentation of fact when it filed the Application, by claiming to be the owner of a Mark of which it was not the owner and claiming that no other person, firm, corporation, or association had the right to use that Mark in commerce when in fact Opposer had such right, and that if the Application matures to registration, Applicant will have obtained that registration based on such false, material claims.

44. Thus, any attempt by Applicant to continue to prosecute this Application, such as by filing an Answer in this proceeding, would constitute fraud on the United States Patent and Trademark Office.

45. Registration of the Mark must be refused. Registration of the applied-for Mark by Applicant would prevent Opposer, which is the rightful owner of that Mark, from registering that Mark itself. Such registration would also cast a cloud over Opposer's ownership of and right to use that Mark, since such registration would give Applicant a rebuttable presumption of an exclusive right to use the ALICE IN CHAINS mark. Thus, registration of the applied-for Mark by Applicant would damage Opposer.

COUNT FIVE
LIKELIHOOD OF CONFUSION

46. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 45 above as if fully set forth herein.

47. The mark sought to be registered by Applicant is identical to Opposer's ALICE IN CHAINS mark.

48. Applicant seeks to register the subject mark for goods and services that are identical or highly related to the goods and services that are and have been offered by Opposer under Opposer's ALICE IN CHAINS mark, and that are associated in the public's minds with Opposer.

49. Registration of the subject mark by Applicant is likely to cause confusion or to cause mistake, or to deceive the trade and public into mistakenly believing that Applicant's goods and services to be offered under the ALICE IN CHAINS mark by Applicant come from the same source as goods and services bearing or sold in connection with Opposer's ALICE IN CHAINS mark, or are otherwise authorized, sponsored, or licensed by Opposer, in violation of Section 2(d) of the Lanham Act, 15 U.S.C. § 1052(d).

50. Registration of the ALICE IN CHAINS mark by Applicant is inconsistent with Opposer's prior uses of the ALICE IN CHAINS mark.

51. By reason of the foregoing, Opposer will be damaged by the registration of the mark shown in Application Serial No. 85/491,584.

COUNT SIX
DILUTION

52. Opposer repeats and realleges the allegations set forth in paragraphs 1 through 51 above as if fully set forth herein.

53. Because of Opposer's use of the ALICE IN CHAINS mark, Opposer's ALICE IN CHAINS mark was both distinctive and famous in the U.S. prior to the filing date of the

Application.

54. Applicant's registration and use of the ALICE IN CHAINS mark would dilute the distinctive quality of Opposer's famous ALICE IN CHAINS mark, in violation of § 43(c) of the Lanham Act, 15 U.S.C. § 1125(c).

55. By reason of the foregoing, Opposer will be damaged by the registration of the mark ALICE IN CHAINS to Applicant.

WHEREFORE, Opposer respectfully requests that this Opposition be sustained and that Application Serial No. 85/491,584 for registration of the mark ALICE IN CHAINS be in all respects denied.

Dated: New York, New York
January 17, 2013

Respectfully submitted,

FROSS ZELNICK LEHRMAN
& ZISSU, P.C.

By: 

Craig S. Mende

Robert A. Becker

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CERTIFICATE OF SERVICE

I hereby certify that I caused a copy of the NOTICE OF OPPOSITION to be served by prepaid, first-class mail on this 17th day of January, 2013, upon Applicant's attorney, Robert C. Cumbow, Esq., Graham & Dunn PC, 2801 Alaskan Way, Suite 300, Seattle, WA 98121-1128.



Robert A. Becker